



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,715	08/22/2001	Hideaki Takahashi	SON-2200	6288
23353 7590 08/13/2007 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			EXAMINER KESACK, DANIEL	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 08/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	09/933,715		TAKAHASHI ET AL.	
	Examiner		Art Unit	
	Dan Kesack		3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-12 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 24, 2007 has been entered.

Status of Claims

2. Amendment filed May 24, 2007 has been entered and fully considered. Claims 1-7, 9-12, and 15-17 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3691

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a second management apparatus for managing second privilege information that is generated in accordance with a transaction by the user in a real world and used for identifying the user in such a manner that..." It is unclear whether the second management apparatus or the privilege information is described by "and used for identifying the user", thus rendering the claim indefinite.

Claim 1 further recites "the transaction that is conducted by the user in the virtual world is made us the IC card". Examiner assumes "us" is a typographical error. Correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3691

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel, et al., U.S. Patent No. 6,594,640, in view of Chen, U.S. Patent No. 6,549,912, and further in view of Davis, U.S. Patent No. 6,282,522.

Claims 1, 11, Postrel teaches a communications system and method comprising: a first management apparatus for managing first privilege information generated in accordance with a transaction that is conducted by a user via a network in a virtual world (user conducts e-commerce transactions, information is managed by reward servers – column 5 lines 17-36), and a user identifier that is used for identifying the user in such a manner that the first privilege information and the user identifier are correlated with each other (user's reward accounts with each reward server – column 6 lines 20-43);

a second management apparatus for managing second privilege information that is generated in accordance with a transaction conducted by the user in a real world and used for identifying the user in such a manner that the second privilege information and the user identifier are correlated with each other (trading server – column 8 lines 39-58),

wherein the second management apparatus converts the first privilege information that is managed by the first management apparatus into privilege information to be managed by itself (column 8 line 65 – column 9 line 21) according to a prescribed conversion factor (column 9 lines 9-12) and manages the privilege information obtained by the result of the conversion, such that the information is automatically converted when the user conducts transactions in the virtual world (wherein the user request is considered conducting a transaction in the virtual world).

Postrel fails to teach the identifier is stored in an IC card.

Chen discloses a loyalty file structure for smart cards wherein user identification information relating to a loyalty program is stored on a smart card (figures 3, 4). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Postrel to include storing identification information on a smart card because the environment in which Chen implements the disclosed invention is identical to the operational environment of Postrel (Postrel discloses the use of the system with a smart card – column 9 lines 55-67), and the smart card identification of Chen provides a convenient way for a card holder to identify himself or herself, and convenience is a desirable feature in the current invention.

Postrel and Chen fail to teach transactions conducted in the virtual world using an IC card.

Art Unit: 3691

Davis discloses an internet payment system and method using a smart card, wherein the a user is able to conduct transactions in the virtual world of the internet using an IC card, containing user information (abstract), including reward point programs. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Postrel and Chen to include the teachings of Davis because Davis teaches the system being used with award points programs over the Internet (column 24 lines 61-67):

Claims 2, 3, 5, 12, 15, Postrel teaches the privilege information is an addable point (column 6 lines 37-40), which describe how much the user is able to redeem, and which is redeemable for service (column 1 lines 13-15).

Claim 4, Postrel teaches the conversion of privilege information taking place in response to a request from the user (column 4 lines 6-11).

Claim 6, Postrel teaches the second management apparatus performing settlement processing in response to a settlement request about a transaction that the user has conducted (column 7 lines 31-41).

Claim 7, Postrel teaches the second management apparatus performs the processing of issuing the point (column 5 lines 11-20).

Claims 9, 16, Postrel teaches the first management apparatus providing the privilege information in accordance with a contribution by the user in the virtual world (user makes a purchase, and points are provided to the user through the reward server – column 5 lines 17-36).

Claims 10, 17, Postrel teaches the second management apparatus providing the privilege information in accordance with a credibility of the user (column 6 lines 1-7).

Response to Arguments

8. Applicant's arguments with respect to 35 U.S.C. 101 have been fully considered and are persuasive. The rejection of claim 11 has been withdrawn.

9. Applicant's arguments with respect to 35 U.S.C. 103 have been fully considered but they are not persuasive.

While some new grounds of rejections render Applicant's arguments moot, Examiner will respond to arguments which he believes are still applicable.

Applicant argues that Examiner has never shown a difference between real world and virtual world transactions. Examiner respectfully disagrees, but has clarified his position by providing additional citations above for what Examiner considers to be the

Art Unit: 3691

first management apparatus associated with the virtual world, and a second management apparatus associated with the real world. Examiner has given the claim language its broadest reasonable interpretation. The claim language does not include limitations for what constitutes a real world transaction or a virtual world transaction. Examiner is of the opinion that a transaction that is conducted by a user using electronic means could be considered either a virtual transaction because of the electronic component, or a real world transaction, because the user is conducting the transaction in the real world, as the user operating a computer is in "the real world". Following this reasonable interpretation, Postrel teaches the invention substantially as claimed.

Conclusion

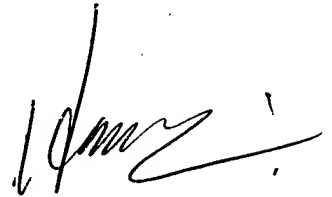
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel Kesack
Art Unit 3691
August 6, 2007



HANI M. KAZIMI
PRIMARY EXAMINER